

### **REMARKS**

Claims 1-10 and 12-17 are pending in this application. Claim 10 is amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. Claim 11 has been canceled without prejudice or disclaimer of its subject matter. The Applicant appreciates the removal of the previous rejections.

### **Information Disclosure Statement**

Applicant timely filed an Information Disclosure Statement, PTO-1449 and references on 18 August 2003, together with the application. The Information Disclosure Statement filed on 18 August 2003 is in full compliance with 37 C.F.R. §§1.97 and 1.98. Accordingly, the consideration of all the references cited in the Information Disclosure Statement filed on 18 August 2003 is respectfully requested.

### **I. REJECTION OF CLAIMS (35 U.S.C. § 103)**

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**A. Claims 1, 4, 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al (US 2002/0107003A1) in view of Oshigiri (US 2001/0014584A1) and further in view of Watson et al (US 6,212,382). The Applicant respectfully traverses.**

1. Regarding claims 1, 4, 6 and 9, the Examiner states that Watson teaches confirming a location of the mobile station by dummy paging (see column 2, lines 45-49).

However, the mobile station sends the message to the base station. The present claims, however, states that *a base station controller... confirming a location of the mobile station by dummy paging* instead of the mobile station informing the base station of the location. Moreover, Watson states that the message is sent to the base station “so that it can be paged if incoming calls arrive (location update).” Therefore, this is not a dummy paging by the base station controller, but a

paging.

2. Regarding claims 1, 4, 6 and 9, the Examiner states that Martin teaches confirming a location of the mobile station and updating the location information stored in said visitor location register when the mobile station keeps up an idle state during a certain period (see [0021] and [0027], see “current location”. The Examiner further states that applicant’s specification fails to further define what an “idle state” is. Therefore, the Examiner states that Martin indeed teaches claimed limitation with the broadest reasonable interpretation).

However, as shown in paragraph 24, the description in paragraph 27 is when the base station is forwarding a call message. The entire claim language must be taken into account which states *confirming a location of the mobile station by dummy paging and updating the location information stored in said visitor location register when the mobile station keeps up an idle state during a certain period*. Therefore, Martin is teaching away from providing a confirmation of the location by dummy paging when the mobile station keeps up an idle state during a certain period of time. Rather, Martin, like Watson is teaching of an MSC using the information already stored in the register via “paging process” rather than dummy paging. Therefore, Martin and Watson are both teaching away from the dummy paging, but rather using ordinary paging. According to MPEP §2145, “It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). These portions of Martin and Watson cannot be just ignored because according to MPEP §2141.02, “A prior art reference must

be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).”

Moreover, there is no teaching as to confirming and updating the location when the idle state is kept for a certain time. No specific idle period is ever mentioned in Martin in paragraph 21, 27. In fact a search of the entire publication of Martin never actually teaches concerning an idle state during a certain period. Respectfully, stating that idle state is not defined in the specification is not a reason to interpret the term so broadly that there is no actual teaching or suggestion in the art. According to MPEP 706.02(j), the prior art reference (or references when combined) must teach or suggest all the claim limitations.

**B. Claims 2, 3, 8, 12, 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al (US 2002/0107003A1) in view of Oshigiri (US 2001/0014584A1) and further in view of Watson et al (US 6,212,382), Stephens (US 6,256,503) and Fitch et al (US 6,424,840). The Applicant respectfully traverses.**

1. First, the remarks above for claims 1, 4, 6 and 9 apply to claims 2, 3, 8 and 12.

2. Regarding claims 2, 3, 8 and 12, the Examiner states that Martin teaches at least one repeater dispersedly installed in sector zones of a private base transceiver station (see Martin, fig. 1), a visitor location register in which location information relating to a private wireless network location of a mobile station is stored (see Martin, [0021] and [0027], see “VLR”) and confirming a location of the mobile station and updating the location information stored in said visitor location register when the mobile station keeps up an idle state during a certain period (see Martin, [0021] and [0027], see “current location”).

However, Martin never teaches or suggests a repeater. As seen in figure 1, the Base station 107 has no repeater installed in sector zones of the private base transceiver station. An MSC 101 is shown connected to the base station and the HLR/VLR, remote HLR and mail system, but no repeater dispersedly installed in the sector zones. There is nothing in Martin that extends the range of the base station as a repeater does in a private base transceiver station.

3. The Examiner admits that the combination of Martin, Oshigiri, Watson and Stephens does not specifically disclose the location information including at least one of a private base transceiver station number, a sector number and a repeater number.

However, the Examiner states that Fitch teaches the location information includes at least one of a base transceiver station number, a sector number and a repeater number (see column 7, lines 8-10).

However, as seen in claim 12, the claim states not “at least one of”, but *the location*

*information including a private base transceiver station number, a sector number and a repeater number with respect to the relevant mobile station.* Fitch only mentions location information including cell or sector identifier, but not all of the sector number, repeater number and private base transceiver station number.

Moreover, concerning claims 2, 3 and 8, the sector number relates to the private base transceiver station as claimed and the base transceiver station number is also private. However, nowhere in Fitch does such sector or cell identifier relate specifically to a private base transceiver station.

4. The combination of references do not teach or suggest that the base transceiver station is necessarily private. The Examiner states that Martin teaches in figure 1 of the private base transceiver station. However, no such disclosure is ever made in Martin in figure 1 or any other disclosure concerning a base transceiver station specifically and that such is private.

A base station is only mentioned, but even that is never taught or suggesting specifically as being private.

5. Regarding claim 13, the Examiner states that the combination of Martin, Oshigiri, Watson, Stephens and Fitch further teaches transmitting the location information received from said private base station controller to the client (see Oshigiri, [0027]), and receiving the location information from said server and providing a user with a location and state of the specific mobile

station according to the received location information (see Oshigiri, [0027]).

However, Oshigiri fails to teach or suggest the transmission of the information from the private base station controller to the client received from the server. In paragraph 27 for example, the base station controller on receipt of the registration message merely recognizes the mobile station identified, but there is no transmission of the information to a separate client and server as claimed for use by a user.

Furthermore, Oshigiri is relating to a public switched telephone network rather than a private base station controller as claimed.

6. The Examiner states that regarding claims 15 and 17, the combination of Martin, Oshigiri, Watson, Stephens and Fitch does not specifically disclose the server being connected to said base station controller through a local area network and the plurality of repeaters being connected to the private base transceiver station, with the private base transceiver station being connected to said private base station controller. However, the examiner takes Official notice that such feature as recited is very well known in the art.

Respectfully, the Examiner is relying on his personal knowledge. According to MPEP §2144.03 relating to “Reliance on Common Knowledge in the Art or ‘Well Known’ Prior Art” such reliance must be judiciously applied. Only in certain circumstances this can be done. The Examiner’s use of his knowledge does not meet the standards set in MPEP §2144.03. Furthermore, it is the right of the Applicant to demand authority be shown for all the reliance of what the

Examiner calls as common knowledge.

In addition, as shown above, Oshigiri and other references fails to even teach or suggest a server and client. Further, there is no actual teaching of the plurality of repeaters as only base stations are mentioned. Further, the connections as mentioned between the repeaters , private base transceiver station and private base station controller and server is not taught or suggested and cannot be assumed to be common knowledge as arranged in the claims.

The Federal Circuit has mentioned that “[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious.” *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964).

7. Regarding claim 16, the Examiner stated that combination of Martin, Oshigiri, Watson, Stephens and Fitch does not specifically disclose a client being informed of the location information from said server, with said client being connected to said server, said server not accommodating the communication link between mobile stations. However, the examiner again takes Official notice that such feature as recited is very well known in the art.

As shown above, the official notice is improper and under MPEP §2144.03, the Applicant has the right to demand authority. The official notice is not being applied in limited circumstances, but rather liberally, which the USPTO discourages as it circumvents the 35USC§103 *Graham v. Deere* factual inquiries as mentioned in MPEP §2141. A finding of obviousness must be based upon



a determination of obviousness under section 103 and not heavily relying on common knowledge.

**C. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al (US 2002/0107003A1) in view of Oshigiri (US 2001/0014584A1) and further in view of Watson et al (US 6,212,382) and Fitch et al (US 6,424,840). The Applicant respectfully traverses.**

Regarding claims 5 and 7, since claims 5 and 7 depend on claims 4 and 6, the above arguments apply.

**D. Claims 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al (US 2002/0107003A1) in view of Garceran et al (US 6,522,888) and further in view of Fitch et al (US 6,424,840) and Giniger et al (US 6,199,045). The Applicant respectfully traverses.**

The above remarks apply to claims 10 and 14, including but not limited to the information including all of the private BTS number, sector number and repeater number with respect to the mobile station, a private base station controller requesting about location information, transmitting

the information of the location to the server and then client.

In addition as seen in claim 14, the references fail to teach or suggest transmission of the location information directly to the server which is remote from the VLR in response to the server request. The Examiner states that Giniger teaches such in col. 11 and 12, but there is no specific teaching or suggestion of *directly* to the server, the location information is being provided. In fact as seen in figure 1 of Giniger, the server 107 is not even directly connected to the visitor location register and so cannot directly provide such information, where the VLR is remote from the server.

Further, claim 10 has been amended to include the limitations of claim 11.

**E. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al (US 2002/0107003A1) in view of Garceran et al (US 6,522,888) and Fitch et al (US 6,424,840) and further in view of Giniger et al (US 6,199,045) and Watson et al (US 6,212,382). The Applicant respectfully traverses.**

Regarding claim 11, the Examiner states that Watson and Martin teaches the features of claim 11, however, as shown above in sections (A) and (B), Watson and Martin fail to teach or suggest all the claimed limitations as mandated by MPEP §706.02(j).

#### **F. Claims 1-17**

Regarding claims 1-17, from col 2, lines 45-49 of Watson, it can be known that Watson does

not teach performing a dummy paging by a base station controller in order to confirm a location of a mobile station.

The present invention teaches performing the dummy paging by the base station controller, not by the mobile station. In the present invention, the mobile station is merely in response to such a dummy paging. That is to say, according to the present invention, the mobile station does not scan the strongest base station signal strength in an idle mode and send the brief signaling message in order to inform its location, unlike Watson.

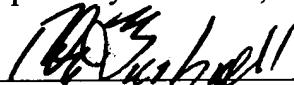
Moreover, the present invention teaches that in the mobile station, the dummy paging is not separated from an ordinary paging and it is even unnecessary to separate the dummy paging from the ordinary paging. Simply, in the base station controller of the present invention, the dummy paging which is separated from the ordinary paging is performed. Separating the dummy paging from the ordinary paging does not mean that a dummy paging method differs from the ordinary paging method. Namely, the dummy paging is not a paging which is performed according to a general call processing process but a paging performed when the mobile station keeps up an idle state during a certain period.

As stated above, according to the present invention, since the mobile station is only in response to the dummy paging unlike Watson, it is unnecessary to change an operation of a general mobile station and to lay on a burden of scanning for the strongest base station signal strength and sending a brief signaling message.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

A fee of \$120 is incurred by filing a petition for a one (1) month extension of time. Applicant's check drawn to the order of the Commissioner accompanies this Amendment. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

  
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